

I. STATUS OF CLAIMS AND AMENDMENT

Claims 1 and 36-57 are now present.

Claims 2-35 are canceled.

The independent claims are 1, 46, and 57. Claims 1, 46, and 57 are method, apparatus, and computer program product analogs of one another.

II. SUMMARY OF PROCEDURAL DELAYS

On 8/23/2003, the applicant filed an amendment and an appeal brief.

On 1/13/2004, the USPTO mailed a notice improperly requiring a appeal brief presenting the versions of the claims pending prior to the 8/23/2003 amendment.

On 2/10/2004, the applicant filed an amended appeal brief to comply with the improper requirement.

On 2/10/2004 the applicant also petitioned to have the improper requirement vacated and the appeal brief filed 8/23/2003 reinstated.

On 9/28/2004, the Tech Center 3600 Director granted the petition and required the examiner to consider the appeal brief filed 8/23/2008. Paper No. 15.

On 12/16/2004, the USPTO issued an office action indicating that it was in response to the communication filed 8/23/2003, thereby reopening prosecution. However, the office action was improperly marked as final.

On 12/23/2004, the applicant petitioned to have the Director vacate the office action dated 12/16/2004, vacate the finality of the office action dated 12/16/2004, and instruct the examiner to issue an answer to the appeal.

On 3/1/2005, the applicant filed a new notice of appeal.

On 5/16/2005, in response to the office action mailed 12/16/2004, the applicant filed a new appeal brief.

On 6/27/2005, the Tech Center 3600 Director denied the petition, as allegedly moot, since the applicant had filed a new appeal brief addressing the new rejections in the improperly final office action. Denial of the request to remove the final status was improper, since finality was improper, and that finality affected the applicant's rights in responding to the allegedly final office action, and since the alleged mootness was entirely the result of the examiner's improper action and the failure of the USPTO to promptly decide the petition.

On 7/26/2005, the USPTO mailed a notice requiring a corrected appeal brief.

On 8/9/2005, in response to the 7/26/2005 paper, the applicant filed a supplemental

appeal brief.

On 6/6/2006, the examiner mailed an examiner's answer.

On 6/16/2006, the applicant mailed a reply brief.

On 8/25/2006, the USPTO mailed a paper acknowledging the reply brief.

On 3/17/2008, the USPTO mailed a paper correcting the record by having the examiner make of record a prior art reference.

On 12/8/2008, the office issued an examiner's answer. This answer states on its face that it is responsive to the appeal brief filed 8/5/2005 appealing the office action of 12/16/2004. This answer contains a new ground of rejection.

In response to the 12/8/2008 examiner's answer, the applicant reopens prosecution and inter alia addresses the new grounds of rejection.

III. REQUEST THAT THERE BE NO FURTHER PROCEDURAL DELAYS

The foregoing section shows that the applicant appealed in 2003, and no decision was rendered for 5 years. The applicant respectfully requests the examiner address the merits and avoid further procedural delays.

IV. SUMMARY OF THE EXAMINER'S ANSWER

The examiner's answer:

1. withdraws that all rejections and objections under 112;
2. newly rejects claims 1, 2, 4-10, 21-26, and 29-30 under 35 U.S.C. 101;
3. cites Plants, Hager, and Price as evidence of prior art;
4. Reiterates the prior 103 rejections by stating that "Claims 1-2, 4-12, 14-27 and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plantz et al. (U. S. 6,088,702) in view of Hager et al. (U. S. 5,377,355). and that "Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Plantz et al. in view of Hager et al. and further in view of Price et al. ("Peering Into Peer Review ");

In response, the applicant amends the claims to moot the rejections, by (1) including tying the method claims to apparatus limitations and (2) by incorporating user rolls and limitations thereto.

V. SUPPORT FOR NEW CLAIM RECITATIONS

The support for the new claim recitations in claim 1 appears in braces ({ }) below, before

the corresponding recitation.

1. (Currently Amended) A computer implemented manuscript review and publication determination process, for determining whether a manuscript is suitable for publication, comprising:

{users and user roles are disclosed on page 6 line 24 to page 7 line 8}

storing in a central computer system a set of users;

storing in said central computer system a set of rolls with respect to manuscripts, including author roll, editor roll, associate editor roll, and reviewer roll, and storing rights and limitations on rights associated with each of those roles, as follows:

(1) author roll rights to submit, view, and obtain status information; and no right to associate any role with any other user, no right to recommend for or against publication;

(2) editor roll rights to associate with other users role of associate editor or reviewer; approve or deny publication, and obtain status information;

(3) associate editor roll rights to associate with other users role of reviewer; approve or deny publication; obtain status information; and no right to associate with another user roll of editor, associate with another user roll of associate editor;

(4) reviewer roll rights to recommend for or against publication; obtain status information; and no right to associate any roll with any other user;

receiving, at said central computer system, from an electronic communications network, manuscript data defining a first manuscript, including at least one of text data, audio data, and video data;

storing, by said central computer system, said first manuscript in a database;

{Page 5 line 15 disclosed the "manuscript identification"}

storing, by said central computer system, a first manuscript identification in association with said first manuscript;

prompting a potential reviewer for agreement to review said manuscript;

{associations of users are specified on page 5 lines 14-19}

associating, in said central computer system, a first user of said set of users with said first manuscript and roll of editor, herein after editor;

associating in said central computer system with a second user of said set of users with said first manuscript and a roll of associate editor, herein after first associate editor;

associating in said central computer system with a third user of said set of users with said

first manuscript and a roll of reviewer, herein after first reviewer;

associating in said central computer system with a fourth user of said set of users with said first manuscript and a roll of author, herein after author;

{response to assigned user queries for manuscript data, including validation, are disclosed on page 6 lines 8-23}

receiving, at said central computer system, from said electronic communications network, a set of tokens specifying a specific user and manuscript, said set of tokens including password, manuscript identification, and a remote address, and a prompt for prompted manuscript data for said first manuscript;

validating, at said central computer system, said set of tokens against data stored in said database by determining if said specific user has a role associated with said first manuscript authorizing transmission of said prompted manuscript data for said first manuscript to said specific user, and if validated, transmitting, from said central computer system, said prompted manuscript data, via said electronic communications network, to said remote address of said specific user;

{reviewer and editor input of data to central computer system, recommendation to reviewer, and decision of editors, is disclosed at page 7 lines 21-page 8 line 2}

receiving, at said central computer system, from a reviewer, one of a recommendation to publish and a recommendation not to publish said first manuscript;

receiving, at said central computer system, from said first associate editor, one of a decision to publish and a decision not to publish said first manuscript;

storing agreement data received from said potential reviewer, said agreement data including at least one of agreement to review and disagreement to review said manuscript;

{storing a final decision whether to publish is disclosed on page 8 lines 1-2}

said central computer system storing a final decision whether to publish said manuscript.

VI. SUPPORT FOR NEW APPARATUS RECITATIONS

Support in the specification for newly added apparatus limitations is identified below.

"central computer system" - See Fig. 2 element 203 ("Central Computer")

"electronic communications network" - See Fig. 2 element 202 ("Communications network")

"database" - See Fig. 2 element 204 ("Database"; "Manuscript Data, Date and Task Information, Assignment Information"))

"remote terminal" - See Fig. 2, "Remote Terminal"; "Manuscript Submission [sic; submission]; Status Information, Review Forms, Final Review, Decission [sic; decision]"

VII. DEFINITIONS IN THE SPECIFICATION

Please note the definitions from the specification:

Page 4 lines 18 et seq.:

"Manuscript," - "A 'manuscript' is a set of data comprised of at least one of the following: text data, audio data, and video data."

Page 5 lines 19 et seq.

"The terms '**monitoring editor**' or '**associate editor**' are used synonymously in this specification. A monitoring or associate editor normally reports to an editor of the publication. "

"'Potential' monitoring editor - refers to a monitoring editor assigned to a manuscript that has not yet accepted or rejected the assignment."

"'Potential' reviewer refers to a reviewer assigned to a manuscript who has not yet accepted or rejected the review assignment."

VIII. DICTIONARY DEFINITIONS

Please note the following dictionary definitions.

The following definitions are copied from the online dictionary,
<http://www.onelook.com>.

1. **Author**

See <http://www.onelook.com/?w=author&ls=a> which contains the following:

"Quick definitions (author)

? noun: writes (books or stories or articles or the like) professionally (for pay)

? noun: someone who originates or causes or initiates something

? verb: be the author of ("She authored this play")"

2. **Editor**

See <http://www.onelook.com/?w=editor&ls=a> which contains the following:

"Quick definitions (editor)

? noun: a person responsible for the editorial aspects of publication; the person who determines the final content of a text (especially of a newspaper or magazine)

? noun: (computer science) a program designed to perform such editorial functions as rearrangement or modification or deletion of data"

3. **Reviewer**

See <http://www.onelook.com/?w=reviewer&ls=a> which contains the following:

"Quick definitions (reviewer)

? noun: someone who reads manuscripts and judges their suitability for publication

? noun: a writer who reports and analyzes events of the day"

4. **Manuscript**

See <http://www.onelook.com/?w=manuscript&ls=a> which contains the following:

"Quick definitions (manuscript)

? noun: the form of a literary work submitted for publication

? noun: handwritten book or document".

IX. **NEW REJECTION UNDER 35 USC 101**

The examiner's answer states that:

Claims 1, 2, 4-10, 21-26, and 29-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 2, 4-10, 21-26, and 29-30 are directed to a "method" and therefore are considered process claims for the purposes of § 101. To qualify as statutory subject matter, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes must positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus the accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). Claims 1, 2, 4-10, 21-26, and 29-30 identify neither the apparatus performing the recited steps nor any transformation of underlying materials. Claim 26, while reciting a computer for transmitting or receiving data, does not require any machine or apparatus (the computer) for any manipulation or transformation of data or signals, thereby constituting a trivial use of technology. Therefore, claims 1, 2, 4-10, 21-26, and 29-30 identify neither the apparatus performing the recited steps nor any transformation of underlying materials and, accordingly, are directed to non-statutory subject matter.

X. RESPONSE TO NEW REJECTION UNDER 35 USC 101

A. BACKGROUND

The specification provides support for tying the claimed inventive "computer implemented process of manuscript review" (specification numbered page 4) to the apparatus performing that process, as shown in the following quotations from the specification:

Figure 2 shows a centralized computer 203. The embodiment of the computer implemented manuscript review entails using the centralized computer 203 in communication with a distributed computer network 202 having remote terminals 201. An author can use the remote terminals 201 to transmit the manuscript via the terminal, 201 and network 202 to the centralized computer 203 via the distributed computer network 202 where it is stored into a database 204. The remote terminal 201 preferably is a personal computer running Web browser software. The distributed computer network 202 preferably is the Internet. The centralized computer 203 preferably is a Web server running Web server software. [Specification numbered page 5 lines 2-9.]

The embodiment of the invention displays unassigned manuscripts to the editor (or the editorial staff) of the publication via one of the remote terminals... [Specification numbered page 5 last 5 lines.]

The terms "free time" and "least amount of work" refer to determinations based up information stored in association with an identification of each editor and reviewer in the database 204. [Specification numbered page 6 lines 5-7.]

The central computer 203, database 204, distributed network 202, and remote terminals 201 preferably are used with one another to provide the secure means of delivering the manuscript to the authorized individual(s). [Specification numbered page 6 lines 9-12.]

The user would transmit a set of these tokens from a remote terminal 201 across the communications network 202 to the central computer 203 to be validated by

data residing in the database 204. [Specification numbered page 6 lines 16-21.]

Each of the tasks can be performed at a remote terminal 201 via a distributed communications network 202 attached to the central computer 203 which stores the manuscript and event tracking information into the database 204.

[Specification numbered page 7 lines 5-8.]

A report can be compiled by the central computer 203 using the data residing in the database 204 and displayed on remote terminals 201 to convey important status information about the manuscript, person, and/or tasks.... [Specification numbered page 7 lines 10-13.]

Automatic messages may be sent over the communications network 202 (via e-mail) in response to status information. [Specification numbered page 7 lines 16-19.]

After a reviewer or monitoring editor has viewed a manuscript, they can use the remote terminal 201 attached to the distributed communications network 202, attached to the central computer 203 and database 204 to store their publication approval or denial decision 118. One embodiment of the system has the remote terminal display a form 117 where the reviewer can enter a decision and additional comments for subsequent storage 118 into the database 204 located on the central computer 203. [Specification numbered page 7 lines 22-27.]

After all of the reviewers have supplied their publication approval/denial decision to the central computer, the editor (or delegated associate editor or staff member) can then correlate the publication approval/denial decision 119 about the specific manuscript and store a final publication approval/denial decision 120.

[Specification numbered page 7 penultimate line to page 8 line 2.]

Moreover, Fig. 2 shows the elements discussed in the foregoing passages, and Fig. 1 shows an exemplary flow chart of an inventive method.

B. EXAMINER'S REASONING

The examiner reasoned that: to qualify as patent eligible, these processes must positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus the accomplishes the method steps), Claim[] 1 [does not] identify ... the apparatus performing the recited steps

C. APPLICANT'S RESPONSE

In response, the applicant submits that claim 1 as amended identifies the apparatus performing the recited steps, namely, the central computer system, database, and electronic communications network, tied to the steps of claim 1. Accordingly, claim 1 meets the requirements specified by the examiner to overcome the new rejection under 101. New claim 57 is a product by process claim which incorporates the same ties to the steps it instructs be performed when installed on a central computer system. Accordingly, these two claims comply with the requirements in the examiner's reasoning and therefore should not be rejected under 35 USC 101. Independent claim 46 is a system claim which expressly recites apparatus limitations and therefore is not subject to rejection under 35 USC 101.

Claims 36-45 depend from claim 1 and provide additional ties to apparatus. Claims 36, 39, 41, 42, additionally tie to a remote terminal and/or remote monitor.

Claims 37 and 38 additionally tie to storing additional data.

Claims 43-45 additionally tie to configuration via programming of the central computer system. Claims 44 and 45 specify a particular kind, and particular brands, of installed programs, relational or partially relational database programs.

XI. SUMMARY OF WITHDRAWN 112 REJECTIONS

The examiner's answer concedes that the 112 rejections were improper, stating at page 5 that "Upon reconsideration, Claim Objections, and Claim Rejections under 35 USC 112. [sic]". Those items were rejections of claims 29, 30, and 32-34 under 35 USC 112, first paragraph for alleged lack of written description and corresponding objections under 35 USC 132. In support of those rejections, the examiner assumed that the specification was silent regarding rights, roles, and tasks. In response, the applicant cited to specification page 6 line 27 to page 7 line 8, wherein the specification expressly discussed roles and tasks, and otherwise disclosed rights. What the applicant reasoned, which the examiner apparently agrees with is that:

The examiner asserts that "rights" "implies ability to execute certain actions and does not require said certain actions to be performed." See Office action mailed 12/16/2004 page 3 lines 15-16. The specification clearly teaches the "ability to execute certain actions and does not require said certain actions to be performed." The specification states that an editor assign an associate editor, an associate editor can assign a reviewer, and a reviewer can view the manuscript. The use of the word "can" in the description of the roles/tasks does not convey obligation for performing certain acts. The ordinary meaning of the word "can" is "to be able to." Thus, stating that the actions can be performed means the "ability to execute ..." Therefore, both the words "rights" and "can" imply an ability to execute certain actions and do not require said certain actions to be performed. Thus, the applicant did not add new matter by using the term "rights" as opposed to "roles" or "tasks." Thus, the rejection of claims 29, 30, and 32-34 based upon 35 USC 112, first paragraph should be reversed.

Accordingly, the applicant believes that the examiner agrees that the applicant did not add new matter by using the term "rights" as opposed to "roles" or "tasks."

Accordingly, the applicant believes that the examiner agrees that stating that the actions can be performed means the "ability to execute ..."

Accordingly, the applicant believes that the examiner agrees that both the words "rights" and "can" imply an ability to execute certain actions and do not require said certain actions to be performed.

XII. REJECTIONS UNDER 35 USC 103 OF CLAIMS 1-2, 4-12, AND 14-34 UNDER 35 U.S.C. 103(A) AS BEING UNPATENTABLE OVER PLANTZ, HAGER, AND PRICE

A. SUMMARY OF REJECTIONS

The answer rejects claims 1-2, 4-12, 14-34 under 35 U.S.C. 103(a) based upon Plantz et al. (U. S. 6,088,702), Hager et al. (U.S. 5,377,355), and Price et al. ("Peering Into Peer Review").

Plantz is directed to computer implemented method of group publishing. Title. Plantz's abstract clarifies that Plantz's "Group Publishing System (GPS) ... [permits] assembly and administration of texts by an unlimited number of authors or editors, each of whom may perform

word processing, document assembly and editing functions on the same or different portions of a group authored project. ... electronically communicating through the GPS with any other user of the system working on the same project...." In other words, Plantz' system is directed to enabling a group of people to collaboratively work together to jointly create a document.

Hager is directed to a system for evaluating invention disclosure to determine whether to pursue a patent. More specifically, Hager is titled in part "... an evaluation vote from users ... in response to... a document". Hager discloses "... data processing system with regard to documents ... such an invention disclosure document ... evaluations ... are automatically solicited from a selected group of evaluators enrolled within the data processing system ... Each evaluation of a document is then stored and the content of all evaluations are then utilized to automatically initiate an additional procedure. ... For example, ... the file is automatically closed... and a report ... generated[;] ... initiate a search request [for additional information]... display of a summary of all evaluations" Abstract.

Hager's disclosure is directed to group evaluation of invention disclosures and whether to pursue patenting them. Hager is therefore directed to an environment in which the contents of the document being reviewed generally will not be shared for evaluation outside of members of the organization in which it was submitted for review. Hager discloses in pertinent part that an evaluator may " vote to initiate a search of the technology disclosed within the invention disclosure document to investigate possible patentability to publish the document, [to] close the file, [or to] abstain from a vote with regard to a particular invention disclosure document... to enter a comment with regard to an invention disclosure document, in addition to a simple vote and/or corroboration."

Peer Review discloses the concept of an editor asking someone in the field of a manuscript, other than the editor, and other than the author, to decide whether to publish the manuscript. Peer Review notes that the reviewer may decline the request to review the manuscript.

Plantz discloses only 2 rolls, author and editor. Hager discloses 2 rolls, reviewer and decision maker. Peer Review discloses a requested reviewer's right to not review.

Amended claim 1 incorporates in the claimed process storing in the central computer system the disclosed rights limitations on Editor, associated Editor, Author, and Reviewer rolls, and defines the process of associating users to those rolls, and execution of those rolls to provide the claimed manuscript review and publication determination process. It is respectfully submitted that the prior art does not disclose or suggest those specific rolls and limitations in

such a process.

Please note that the examiner's reasoning for motivation to combine Plantz and Hager was that "combining both reviewing and editorial functionality in one system [sic; in one user, Plantz's disclosed "editor"], with the benefit of enhancing the performance of the system and thereby making it more attractive to customers." Answer paragraph spanning pages 12 and 13. Assuming *arguendo* the correctness of that conclusion, then there is no motivation to combine Plantz and Hager with respect to *amended* claim 1, because amended claim 1 expressly recites the limitations on rights of editor and reviewer, precluding the alleged benefits in performance noted by the examiner. That is, as amended, the reviewer cannot be the editor, and vice versa. This is due to the fundamentally different goals of Plantz, Hager, and the claimed invention. Plantz, directed to collaborative creation, Hager, directed to invention disclosure evaluation, and the claimed invention directed to peer reviewed publications.

In addition, nothing suggests the 4 rolls now specified by claim 1.

Accordingly, the applicant respectfully submits that claim1 as amended is not obvious over the applied prior art. The same reasoning is applicable to all other claims.

Therefore, the rejections of all claims should now be withdrawn.

2-6-2009

DATE

Respectfully Submitted,

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Attorney of Record

RAN

Date/time code: February 6, 2009 (9:10am)

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